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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/602,630 | 06/25/2003 | Seung-Hoon Kim | 1293.1767 | 8987 |
| 21171 | 7590 | 01/24/2006 | EXAMINER | |
| STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | PHAM, VAN T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2656 | |

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/602,630 | | KIM, SEUNG-HOON | |
| | Examiner | | Art Unit | |
| | VAN T. PHAM | | 2656 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 12/23/2004 is acknowledged.

Drawings

3. Figures 1-2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2656

5. Claims 1, 3, 5, 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, and 3-5, of Application No. 10/624,561. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the features recited in claims 1 and 3 of the present application are included in claims 1, and 3-5, of Application No. 10/624,561 ('561), despite a slight difference in wording.

Regarding claim 1, '561 recites in claim 1 more details how to determine the location of the optical pickup by having the counts a number of ATIP syncs for one rotation of the optical number of counted ATIP syncs with a reference number of ATIP syncs, and determines the current position of the pickup based on a comparison result. Therefore, it is obvious that applicant omit the details of determine the location of the optical pickup by having the counts a number of ATIP syncs for one rotation of the optical number of counted ATIP syncs with a reference number of ATIP syncs, and determines the current position of the pickup based on a comparison result. Moreover, '561 recites the pickup is present in an area of the optical disk that is greater than or equal 95 minutes which is the area more than 90 minutes of the optical disc of claim 1.

Regarding claim 3, a memory storing reference rotation speeds of the spindle motor (see '561 the reference number of ATIP syncs (claim 3)) for different area of the disc (see '561 for each track); a comparator comparing the rotational speed of the spindle motor (see '561 (claim 3) the number of counted ATIP syncs) at the current location of the pickup with the reference rotational speeds (see '561 (claim 3) reference number of ATIP) and outputting a comparison result indicative thereof (see the comparison result); and a location determination unit determining whether the pickup is present in a lead-in area when a current rotational speed is

Art Unit: 2656

faster than the reference rotational speed at an inner area of the optical disc (see '561 claim 5) and determines whether the pickup is present in another area other than the lead-in area when the current rotational speed is slower than the reference rotational speed in an outer area based on the comparison result (see '561 claim 4) (note: claim 3 is the combination of '561 claims 3+5+4 and instead of "the number of counted ATIP syncs" and " applicant recites "the rotational speed of the spindle motor" which is the same meaning).

Regarding claim 5, see the rejection above of claims 1 and 3.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims include all of the features of the instant application claims, except for deletion of limitations. The instant "application claims are generic to species of invention covered by the patent claim, and since without terminal disclaimer, extant species claims preclude issuance of generic application claims" (See *In re Goodman*, 29 USPQ2d 2010) and deletion of the additional limitations in the patent claims would have been obvious to one of ordinary skill in the art.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 5 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission

Art Unit: 2656

amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: how "the pickup is determined to be located in an area of more than 90 minutes of the optical based on ATIP information recorded on the optical disc" by a controller measuring a rotational speed of the spindle motor?

Claims 2-4, 6-7 and 9-15 fall with respective parent claim.

Claim Objections

8. Claims 1, 5, 8 are objected to because of the following informalities:

Claims 1, 5 and 8 have phrases "ATIP" need to be defined from what abbreviation.

Appropriate correction is required.

Allowable Subject Matter

9. Because the scope of claims is undeterminable due to the 112, second paragraph, issues rejection statement in the 112, second paragraph, rejection above art cannot be applied in this Office Action.

Cited References

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited references relate to

- a. An ATIP information format for a lead-in region of the CD-R/RW (Osakabe US 2002/0150394).
- b. The method and apparatus for testing the quality of an optical disk medium moves an optical disk into a testing position (Yeo et al. US 6,058,086)

Art Unit: 2656

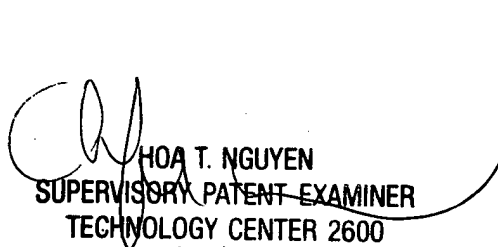
- c. Control signals have been applied to the optical pickup to move the pickup to the desired location in the lead-in area of the disk (Jeong et al. US 2004/0001397).
- d. Apparatus and method for determining area of optical disc (Lee et al. US 2004/0081430).
- e. A location encoder for detection the location of the optical pickup (Ogasawara et al. US 2001/0009539).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN T. PHAM whose telephone number is 571-272-7590. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on 571-272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VP


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1/21/06